

REMARKS

By this amendment, claims 1, 7, 8 and 10 have been modified to overcome the rejections under 35 U.S.C. §112, second paragraph.

Applicant previously appealed this case, but the Examiner removed the finality of the last Office Action, indicating that Applicant made a "request for reconsideration of the finality of the rejection." Claims 1, 2 and 4 stand rejected under 35 U.S.C. §102(b) by Garfinkle, U.S. Patent No. 4,777,750. Applicant's arguments with regards to this grounds for rejection with respect to these claims has already been made of record, and such arguments are incorporated herein by reference.

Claims 1, 2, 3 and 8 stand rejected under 35 U.S.C. §102(b) over Whitman, U.S. Patent No. 3,204,355, newly cited. Without addressing the various specific limitations set forth in the dependent claims, it is clear that the message-bearing panel of Whitman is clearly not "integral" to the sleeve and, more particularly, is not integrally formed through a molding process. Reference is made to column 2, last line, where it is explained that the sign is "affixed" to the upper portion of the post. "The sign holder 30 may be affixed to the post end by means of a pair of screws extending through holes 54 defined in cylindrical portion 48 of the sign holder which screw into the post itself and the screw 56 extending through the rear of the post ..." (column 3, lines 35-39). Although the Examiner maintains the argument that it is held that the term "integral" is sufficiently broad to embrace construction by fastening and welding, as discussed in Applicant's appeal brief of record, the claims at issue contain more than "integral" and include references to formation through a molding process, which the prior art does not have. Accordingly, the *In re Hotte* case does not apply.

Claims 5, 8, 9, 10 and 11 stand rejected under 35 U.S.C. §103(a) over Garfinkle. With regard to claim 5, the Examiner states that an inner diameter of the range of 2 to 8 inches does not solve any stated problem or is for "any particular purpose," but this is not the case. As explained of record, the inner diameter is in this size range to fit over existing stanchions which have an outside diameter in this size range as well. The same argument holds true with respect to claim 8.

Claim 9 includes the limitation of a decal which is also integrally formed in the same mold. Although claim 9 is purportedly rejected over Garfinkle on obviousness grounds, the Examiner makes not argument, presumably because the claim is allowable.

With respect to claims 10 and 11, the Examiner states that the indicia or message does not have

an unobvious function [sic] relationship with respect to the panel, so it is not given any patentable weight. However, given that these claims have been examined, it is not the relationship that they have with the panel which should be given patentable weight, but the positive recitations themselves. Consideration of this point is respectfully requested.

Claim 3 stands rejected under 35 U.S.C. §103(a) over Garfinkle in view of Shuman, U.S. Patent No. 4,329,800. In rejecting this claim, the Examiner combined Garfinkle and Shuman, U.S. Patent No. 4,329,800. As Shuman does include plastic parts, the Examiner states that it would have been obvious to construct the device Garfinkle with the polymeric material of Shuman to provide a lightweight and less costly display device. However, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembiczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, Garfinkle makes no mention whatsoever as to excess weight and, in fact, solves a different problem entirely, namely, the use of various interchangeable parts so that common pieces may be integrated without other pieces of a "kit" in order to enable one to achieve enhanced flexibility in dissimilar environments (column 1, lines 50-56). Garfinkle makes specific reference to metal frames, and includes multiple intricate component parts which could exhibit less structural integrity if constructed from plastic. Thus, in this sense, Garfinkle teaches away from the use of plastic parts. Given that there is no teaching or suggestion from the prior art to form the combination suggested by the Examiner, prima facie obviousness has not been established.

Based upon the foregoing amendment and comments, Applicant believes all claims are in condition for allowance. Questions regarding this application should be directed to the undersigned attorney at the telephone/facsimile numbers provided.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

Serial No. 09/855,087

- 5 -

32003sh

Respectfully submitted,

By: 

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh, Sprinkle,

Anderson & Citkowski, P.C.

280 N. Old Woodward Ave., Ste 400

Birmingham, MI 48009

(734) 913-9300 FAX (734) 913-6007

Date: March 20, 2003

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. (Twice Amended) A combined stanchion cover and signage system, comprising:
an elongated sleeve having a closed top and an open bottom defining a length, enabling the sleeve to be placed over a post or stanchion to be covered; and
a message-bearing panel integrally formed with the sleeve using a molding process; the message-bearing panel [and] extending above the closed [end thereof] top of the sleeve, the panel having a height which is substantially less than the length of the sleeve.

7. (Twice Amended) The combined stanchion cover and signage system of claim [6] 1, wherein the message-bearing panel [includes an informational] is in the form of a decal included [in the mold during the formation thereof] during the same molding process.

8. (Twice Amended) A combined stanchion cover and sign holder, comprising:
an elongated generally cylindrical sleeve of polymeric material, having a closed top, an open bottom, and an inner diameter in the range of 2 to 8 inches; and
a [sign] holder for a sign extending above the closed top of the sleeve.

10. (Amended) The combined stanchion cover and signage -bearing panel system of claim 1, wherein the message concerns parking or traffic flow.